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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,220	08/13/2001	Brian Minear	010240	2135

23696 7590 11/17/2004

Qualcomm Incorporated  
Patents Department  
5775 Morehouse Drive  
San Diego, CA 92121-1714

EXAMINER
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HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/929,220

Applicant(s)

MINEAR ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 33-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 and 42-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of claims 1-32 and 42-45 in the reply filed on August 16, 2004 is acknowledged. The traversal is on the ground(s) that all pending claims are classified in class 705. This is not found persuasive because the determination for a proper restriction is whether the claims are directed to separate and distinct inventions and not whether the claims have a common classification. In the present application, claims 1-32 and 42-45 are directed to an invention that accounts for the use of subscription-based software applications using application download data and deletion data. Claims 33-41 are directed to receiving and transmitting data over a wireless network. Although dependent claims 37 and 41 recite an accounting module, the claims as a whole are not directed to accounting for the use of subscription-based software applications using application download data and deletion data.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20 and 42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims recite functional

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descriptive material which is not tangibly embodied on a medium and is therefore deemed to be non-statutory subject matter as per MPEP 2106.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-32 and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Javed (US PG PUB 2001/0036271 A1) in view of Edelman (US 2002/0029347 A1).**

Referring to claims 1, 4-7, 11, 12, 15-20, 25-32, and 42-45, Javed teaches a system for providing downloadable subscription-based software to one or more wireless devices, comprising:

- one or more wireless devices, each wireless device in selective communication with a wireless network and selectively downloading one or more subscription-based software applications to be executable on the wireless device, (page 1, section [0015]; page 2, section [0016]; page 3, section [0045]; page 7, section [0077]);
- one or more application download servers, each application download server selectively communicating with the one or more wireless devices across the wireless network and downloading to the wireless devices at least one subscription-based software application, each application download server generating subscription-based application download data

for each subscription-based software application downloaded by a wireless device therefrom (page 3, sections [0042], [0043]; page 4, section [0049], [0050]);

- an accounting module to account for the use of subscription-based software applications by each wireless device, the accounting module receiving subscription-based application download data from the one or more application download servers (page 4, section [0050], [0052]).

Javed does not teach deleting a subscription-based application from a wireless device or application deletion data. However, Edelman teaches deleting a subscription-based application from a wireless device and transmitting deletion data (§§ 0058, 0062, and 0096). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Edelman into the system of Javed. One of ordinary skill in the art would have been motivated to do so in order to allow a user to make to terminate a licensing agreement. Javed and Edelman do not teach that the accounting is based upon the combination of the subscription-based software application download data and the subscription-based application deletion data. However this limitation is rendered obvious over Javed and Edelman. Both Javed and Edelman teach downloading subscription-based services over a wireless network. Furthermore, Javed teaches that the subscription-based service can be rented, and Edelman teaches that the subscription-based service can be deleted from the wireless device to terminate a licensing agreement. Furthermore, Edelman teaches that the license data can include an expiration date (§ 0034). Therefore it would have been

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obvious to one of ordinary skill in the art, at the time the invention was made, to allow a user to notify the VISP or the VPOP (i.e. application server) that the rental / license period was over by transmitting deletion data to the server. One of ordinary skill in the art would have been motivated to do so in order to stop charging a user for an expired rental / license agreement. Javed does not teach that the wireless device is configured to transmit voice communication from a user to the wireless network. However, Edelman teaches that his electronic device can be a cell phone (§ 0062). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate voice communication into the system and method of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a user to carry out oral communication using the wireless device.

Referring to claims 2, 3, 13, 14, and 21-24, Javed teaches that the accounting module is resident on the application download server from which a subscription-based software application was downloaded (Figure 2, items "224" and "234"; page 3, section [0046]).

Referring to claims 8-10, Edelman teaches that the device is a cellular telephone, PDA, etc (§ 0057 and 0062). Furthermore, Javed teaches that his system maybe implemented on other architectures that do not depart from the spirit and scope of the invention (page 3, section [0045]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Edelman into the invention of Javed. One of ordinary skill in the art would have been

motivated to do so in order to implement the invention of Javed on devices that are well known and commercially successful.

### ***Response to Arguments***

Applicants' arguments filed March 26, 2004 with respect to the 103 rejection have been fully considered but they are not persuasive. The Applicants have argued that the cited prior art teaches distributing "digital content" and not "applications" or "programs". The Examiner respectfully disagrees. The Applicants' specification teaches that an "application" can be "...games, printed media, stock updates, news, or any other type of information or program available for download through the wireless network." (emphasis added; page 1, lines 18-23). The Examiner notes that Javed's "content" is a program available for download through a wireless network. The Applicants' have also argued that Javed's system is hard wired and is not a packet switched network. The Examiner disagrees. Javed discloses a wireless system (§ 0045). Furthermore, the Examiner notes that the Internet is inherently a packet switched network and cites the reference "A Glossary of Selected Internet and Computing Terms" (page 3) to support this point. The Applicants have also argued that Javed's use of the term "subscription" is not the same as the Applicants' use of the term "subscription". The Examiner disagrees. Although an Applicant can be his own lexicographer, the Examiner notes that in this particular case neither the Applicants nor Javed have provided a specific definition for the term "subscription". As such both Javed's and the Applicants use of this term is given its ordinary meaning.

Applicants' arguments, with respect to the rejection of claims 1-25 over the Munyan reference have been fully considered and are persuasive. Therefore, the reference has been withdrawn. However, upon further consideration, a new ground of rejection is made in view of Edelman.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (703)-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

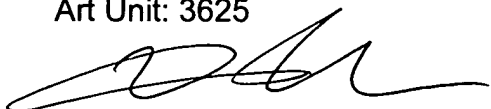
**Naeem Haq**, Patent Examiner  
Art Unit 3625

  
**WYNN W. COGGINS**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

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A handwritten signature in black ink, appearing to be 'D. L. B.', written in a cursive style.

November 12, 2004